

Applicants: Kenneth A. Jones, et al.  
Serial No.: 09/471,572  
Filed: December 23, 1999  
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### **REMARKS**

This Amendment is being filed in response to the Office Action dated February 22, 2005. Claims 184-190 were pending in connection with the above-identified application. By this Amendment, Applicants have canceled claims 184-190 and added new claims 191-196. Accordingly, upon entry of this Amendment, claims 191-196 will be pending and under examination.

Applicants thank the Examiner for the indication on page 6 of the February 22, 2005 Office Action that previous claims 186 and 189-190 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have rewritten previous claims 186 and 189-190 as new claims 191-196. Support for new claims 191-196 may be found *inter alia* in the specification as originally filed on page 29, lines 18-21; page 32, lines 9-12; page 32, lines 19-27; page 3, lines 5-10; page 78, lines 6-34; and page 88, lines 6-14.

Applicants maintain that this Amendment raises no issue of new matter. Accordingly, Applicants request entry of this Amendment.

### **Rejection Under 35 U.S.C. §112 First Paragraph**

On page 2 of the February 22, 2005 Office Action, the Examiner rejected claims 184-185 and 187-188 under 35 U.S.C. §112, first paragraph, because the specification allegedly does not reasonably provide enablement for isolated nucleic acids encoding chimeric G proteins which vary at least five, but less than twenty-one amino acids. However, the Examiner acknowledged that the specification is enabling for an isolated nucleic acid encoding a chimeric G protein wherein the G protein has the amino acid sequence as set forth in SEQ ID NOs: 1 – 5 and 41.

The Examiner alleged that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

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commensurate with these claims. The Examiner further alleged that claim 184 and 187 are overly broad in the recitation of "at least five, but not more than twenty one contiguous amino acids" since insufficient guidance is provided as to which of the nucleic acid species encoding the myriad of polypeptide species encompassed by the claim will retain the characteristics of a Gαq subunit, since no functional limitation is recited in the claim.

On page 5 of the February 22, 2005 Office Action, the Examiner rejected claims 184-185 and 187-188 under 35 U.S.C. §112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner alleged that this is a genus claim and that according to the specification, the term variant means a protein having one or more amino acid substitutions, deletions, insertions and/or additions made to SEQ ID NO: 1-5, 41.

Contrary to the Examiner's statements, Applicants point out that previous claims 184-185 and 187-188 neither recite the phrase "at least five, but not more than twenty one contiguous amino acids" nor the term "variant". However, in an attempt to advance the prosecution of the subject application, but without conceding either the correctness of the Examiner's position or the need for amendment, applicants have canceled claims 184-190 and added new claims 191-196.

Applicants maintain that new claims 191-196 meet the requirements of 35 U.S.C. 112, first paragraph. Applicants further maintain that previous claims 186 and 189-190 have been rewritten in independent form including all of the limitations of the base claim, as new claims 191-196, as suggested by the Examiner.

Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the extra claim fee of \$600.00, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-3201.

Respectfully submitted,



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